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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,675	03/19/2001	Ryoichi Imanaka	8861-402US (P24583-01)	9394

570 7590 10/05/2005

AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER
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LE, MIRANDA

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,675

Applicant(s)

IMANAKA ET AL.

Examiner

Miranda Le

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/18/2005 has been entered.

2. This communication is responsive to Amendment, filed 07/18/2005.

Claims 33-38 are pending in this application. Claims 33, 36 are independent claims. In the Amendment, claims 27-32 have been cancelled, claims 33-38 have been added. This action is made non-Final.

3. The objection to the specification (Claim objections) of the invention has been withdrawn in view of the amendment.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless:

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only

if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 33, 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Kataoka et al. (US Patent No. 5,857,021).

Kataoka anticipated independent claims 33, 36 by the following:

**As per claim 33**, Kataoka teaches (see Fig. 6) a recording method for recording data on a recording medium, said recording medium having a unique ID recorded thereon, the recording method comprising:

reading the unique ID from the recording medium (i.e. checks whether or not the storage medium 5 contains a medium ID, col. 4, lines 64-65, step S22 in Fig. 6);

encrypting the data using the unique ID to generate an encrypted data (i.e. The subject data is encrypted, col. 4, lines 18-20, step S25 in Fig. 6, Fig. 4); and

recording the encrypted data on the recording medium (i.e. The encrypted data is written into the storage medium 5, col. 5, lines 20-21, step S26 in Fig. 6);

It should be noted that, Fig. 4 shows data recorded in a storage medium including security control information, e.g. medium ID and encrypted data.

**As per claim 36**, Kataoka teaches (see Fig. 7) a reproducing for reproducing data from encrypted data stored in a recording medium, said recording medium data using a unique ID recorded thereon, the reproducing method comprising:

reading the unique ID from the recording medium (i.e. the security controller 12 examines whether or not the storage medium 5 contains a medium ID, col. 5, lines 36-44, step 32 in Fig. 7);

decrypting the encrypted data using the unique ID to generate a decrypted data; (i.e. the data is decoded, or decrypted, col. 5, lines 65-66, step 37 in Fig. 7);

producing the decrypted data (i.e. The decoded data is stored in a local storage unit in the terminal, col. 6, lines 1-2, step 38 in Fig. 7).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 34, 35, 37, 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Kataoka et al. (US Patent No. 5,857,021), in view of Teshima et al. (US Patent No. 6,272,470).

**As to claims 34, 37,** Kataoka does not explicitly teach said data is image data generated by a diagnostic instrument. However, Teshima teaches image data generated by a diagnostic instrument (i.e. diagnostic X-ray system in Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kataoka with the teachings of Teshima to include "image data generated by a diagnostic instrument" in order to provide an electronic clinical recording system

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for a wide-area hospital information system enabling the whole of a region to share medical information at low cost without any concern about a difference in type of equipment.

**As to claims 35, 38,** Kataoka does not specifically teach said data is an electronic clinical chart. However, Teshima teaches electronic clinical chart (i.e. medical information, col. 3, lines 33-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Kataoka with the teaching of Teshima to include “an electronic clinical chart” in order to provide an electronic clinical recording system for a wide-area hospital information system enabling the whole of a region to share medical information at low cost without any concern about a difference in type of equipment.

#### ***Response to Arguments***

8. Applicant's arguments regarding neither Teshima, Omiro et al. nor Fukusushima make new claims 33-38 obvious have been considered but are moot in view of the new ground(s) of rejection.

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*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (571) 272-4107. The fax number to this Art Unit is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Miranda Le  
September 29, 2005



JEAN M. CORRIELUS  
PRIMARY EXAMINER